

REMARKS/ARGUMENTS

Reconsideration and allowance of the above-identified patent application are respectfully requested. Claims 1, 3-6, 8-9, 12-14, 17, and 81-82 are pending in this application.

Election / Restriction

The Applicants confirm election of claims 17 and 18 with traverse. Claim 18 has been canceled since it is an improper dependent claim. While it recites additional features than claim 17, in some ways it is broader than claim 17 in that it covers presence of a melting point in other regions. The Applicants apologize for the confusion that might have been caused by claim 18.

The Applicants have amended claims 1, 3-6, 8-9, 12-14, and 81-82 (all of the pending claims) to incorporate all the features of the product claim 17. Once claim 17 is deemed allowable, the Applicants would appreciate rejoinder of all the claims having all the features of claim 17.

This election is made with traverse because it is believed that the claims can be regrouped into a single group. As the Examiner is aware, there are two criteria for a restriction requirement: (A) the inventions must be independent or distinct as claimed; AND (B) there must be a serious burden on the Examiner. "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct invention." MPEP §803.

The Applicants respectfully request that all the pending claims be examined together. All the pending claims are sufficiently similar to make it possible to examine these claims without serious burden, with minimal search and extensive overlap of art. The Applicants believe that such regrouping would expedite prosecution of the present case.

Rejection Under Section 103

The Office Action rejects claims 17 and 18 under 35 U.S.C. § 103(a) as obvious over U.S. Pat. No. 5,399,578 ("the '578 patent"). The cancellation of claim 18 renders this rejection moot as to that claim. As to claim 17, the Applicants respectfully traverse this rejection.

According to M.P.E.P. § 2143, “to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See also In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

As the Examiner is aware, melting is the thermal disordering of a crystalline lattice. Therefore crystalline solids generally exhibit a melting point (some crystalline solids decompose before melting). However, the solid of the present invention, being purely amorphous, does not have any crystalline order. Therefore does not melt, and does not have a melting point. This lack of a melting point is demonstrated in the lack of any endothermic peak present in the DSC thermogram, Figure 3. (Since melting takes thermal energy, one would expect to see an endothermic peak at the melting point.)

According to the Office Action, the ‘578 patent discloses valsartan with a melting point of 105 to 115°C. (‘578 patent, col. 34, l. 62). Because it exhibited a melting point, that valsartan was at least partially crystalline, and not completely amorphous.

The difference between the prior art and the present invention is that the prior art disclosed valsartan containing crystalline valsartan, and the present invention is amorphous valsartan, without detectable crystalline material, as evidenced by the lack of a melting point.

At the time of filing this application, preparation of amorphous valsartan lacking a melting point was not within the skill of the art. According to WO 02/06253, “The X-ray diffraction diagram [of amorphous valsartan] consists essentially of a very broad, diffuse X-ray diffraction; the free acid is therefore characterized as almost amorphous under X-ray. The melting point linked with the measured melting enthalpy of 12kJ/mol unequivocally confirm the existence of a considerable residual arrangement in the particles or structural domains for the free acid valsartan. There is a need for more stable, e. g. crystalline forms of valsartan...” (WO 02/06253, p. 2). Indeed, the Applicants of WO 02/06253 gave up on amorphous valsartan free of a melting point altogether, and pursued salts of valsartan instead.

The failure of the Applicants of WO 02/06253 in obtaining amorphous valsartan and their skepticism that such amorphous valsartan free of a melting point could exist is an

objective criterion of non-obviousness. See M.P.E.P. § 2141 (stating that objective criteria of non-obviousness include “unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts”).

As evident by WO 02/06253, there was a long-felt need to have amorphous form free of a melting point, but others failed to obtain such amorphous form which the present applicants obtained unexpectedly. The Applicants of WO 02/06253 were so skeptical that such amorphous form exists, that they shifted their efforts to salts of valsartan and effectively taught away that amorphous form of valsartan can be obtained free of a melting point.

Further, amorphous form of valsartan is highly desired for preparing pharmaceutical compositions. As the Examiner is aware, the amorphous form generally has higher bioavailability than the crystalline form. Having purely amorphous valsartan is desirable, as any crystal in the material present in the valsartan might have a different bioavailability. Further, the presence of even small amounts of crystalline material can adversely affect the stability of an amorphous product, catalyzing conversion to a crystalline form by providing seeds for crystallization. To meet the regulatory requirement of a uniform product, amorphous valsartan free of a melting point, as claimed, is highly desirable.

In light of the foregoing arguments, the rejection of claim 17 under 35 U.S.C. § 103(a) as obvious over the ‘578 patent cannot stand and should be withdrawn.

Rejection under Section 112, second paragraph

The Office Action rejects claims 17 and 18 under 35 U.S.C. § 112, second paragraph as vague and indefinite. The cancellation of claim 18 renders this rejection moot as to that claim. As to claim 17, the Applicants respectfully traverse this rejection.

A claim is properly rejected as vague and indefinite under 35 U.S.C. § 112, second paragraph where the Examiner finds that a person having ordinary skill in the art would not understand what is being claimed when reading the claim language in light of the “content of the particular application disclosure”, the “teachings of the prior art”, and the “claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made”. M.P.E.P. § 2173.02; *see also Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986).

The descriptive phrase “above about” in claim 17 is not indefinite. Its meaning is not as broad and arbitrary as contended by the Office Action. The meaning of the term “about”

has been held by the courts to be clear, but flexible, and, thus, an appropriate way to define an invention. See *Ex parte Eastwood*, 163 U.S.P.Q. 316, 317 (C.C.P.A. 1968); M.P.E.P. § 2173.05(b). For example, the court in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557 (Fed. Cir. 1983), held that the claim limitation "exceeding about 10% per second" satisfied the definiteness requirement because infringement could be readily assessed by one of skill in the art through the use of a stopwatch. Claim 17 in the current application is no different. The phrase "above about 1 J/g" is definite because one of skill in the art can readily assess whether he is infringing through the use of differential scanning calorimetry. The rejection of claims 17 and 18 under 35 U.S.C. § 112, second paragraph, therefore, cannot stand and should be withdrawn.

Having addressed all the outstanding rejections and objections, Applicants submit that the application is in a condition for allowance. If any outstanding issues remain, the examiner is invited to telephone the undersigned at the telephone number indicated below to discuss the same. No fee is believed to be due for the submission of this response. Should any fees be required, please charge such fees to Kenyon & Kenyon, LLP Deposit Account No. 11-0600.

Respectfully submitted,
KENYON & KENYON

Dated: Dec 14, 05

By: Payam Moradian
Payam Moradian (Reg. No. 52,048)

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004
Tel: (212) 425-7000
Fax: (212) 425-5288